

8/1642
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application. No. : 09/434,382 Confirmation No. : 3879
Applicant : Sean V. TAVTIGIAN et al.
Filed : 5 November 1999
TC/A.U. : 1642
Examiner : Anne L. Holleran

Docket No. : 2318-247
Customer No. : 6449

RESPONSE

Director of the United States Patent
and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

In response to the Office Action mailed 19 February 2004, Applicants submit herewith a Terminal Disclaimer with respect to U.S. Patent No. 6,333,403. The filing of this Terminal Disclaimer obviates the rejection of claims 61-63, 67-77 and 80-82 for obviousness-type double patenting over this same patent.

Applicants submit that all of the claims are now in condition for allowance and request reconsideration of this application and early notice of allowance.

Respectfully submitted,

By

Jeffrey L. Ihnen

Attorney for Applicants

Registration No. 28,957

ROTHWELL, FIGG, ERNST & MANBECK, p.c.

Suite 800, 1425 K Street, N.W.

Washington, D.C. 20005

Telephone: (202)783-6040



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TERMINAL DISCLAIMER

Director of the United States Patent
and Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

The owners, MYRIAD GENETICS, INC., UNIVERSITY OF UTAH RESEARCH FOUNDATION and HOSPITAL FOR SICK CHILDREN, of one hundred percent (100%) interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. §§ 154 to 156 and 173, as shortened by any terminal disclaimer filed prior to the grant of U.S. Patent 6,333,403. The owners hereby agree that any patent so granted on the instant application shall be enforceable only for and during such period that it and U.S. Patent 6,333,403 are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 to 156 and 173 of U.S. Patent 6,333,403, as shortened by any terminal disclaimer filed prior to the patent grant, in the event that any such granted patent: expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 C.F.R. § 1.321, has all claims

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Application No. 09/434,382
Terminal Disclaimer dated 19 May 2004

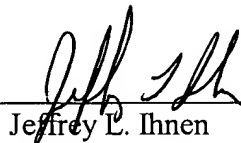
cancelled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as shortened by any terminal disclaimer filed prior to its grant.

The undersigned is an attorney of record.

The terminal disclaimer fee under 37 CFR 1.20(d) is included.

Respectfully submitted,

By



Jeffrey L. Ihnen

Attorney for Applicants

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FEE TRANSMITTAL
for FY 2004
(Large Entity)

FEE TRANSMITTAL for FY 2004 (Large Entity)		<i>Complete if Known</i>	
		Application Number	09/434,382
		Filing Date	5 November 1999
		First Named Inventor	Sean V. TAVTIGIAN
		Examiner Name	Anne L. Holleran
		Group Art Unit	1642
Total Amount of Payment	(\$) 110	Attorney Docket Number	2318-247

METHOD OF PAYMENT (check one)

1. ☒ The Commissioner is hereby authorized to charge additional fees and credit any overpayment to Deposit Account Number 02-2135 in the name of Rothwell, Figg, Ernst & Manbeck

☒ Charge any Additional Fee Required Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status

2. ☒ Payment Enclosed

☒ Check

☐ Credit Card

FEE CALCULATION

1. FILING FEE

Fee Code	Fee \$	Fee Description	Fee Paid
1001	770	Utility filing fee	[]
1002	340	Design Filing Fee	[]
1003	530	Plant Filing Fee	[]
1004	770	Reissue Filing Fee	[]
1005	160	Provisional Filing Fee	[]

SUBTOTAL \$

2. CLAIMS

	Extra Claims	Fee	Fee
Paid			
Total Claims	[] - 20** = []	x \$18 = []	
Independent Claims	[] - 3** = []	x 86 = []	
Multiple Dependent Claims	+ 290 = []		

**or number previously paid, if greater;

SUBTOTAL \$

FEE CALCULATION (continued)

3. ADDITIONAL FEES

Fee Code	Fee Paid	Fee Description	Fee Paid
1051	130	Surcharge - late filing fee or oath	[]
1052	50	Surcharge - late provisional filing fee or cover sheet	[]
1053	130	Non-English specification	[]
1812	2,520	For filing a request for reexamination	[]
1804	920	Requesting publication of SIR prior to Examiner action	[]
1804	1,840*	Requesting publication of SIR after Examiner action	[]
1251	110	Extension for reply within first month	[]
1252	420	Extension for reply within second month	[]
1253	950	Extension for reply within third month	[]
1254	1,480	Extension for reply within fourth month	[]
1255	2,010	Extension for reply within fifth month	[]
1401	330	Notice of Appeal	[]
1402	330	Filing a brief in support of an appeal	[]
1403	290	Request for Oral Hearing	[]
1451	1,510	Petition to institute a public use proceeding	[]
1452	110	Petition to revive -unavoidable	[]
1453	1,330	Petition to revive - unintentional	[]
1501	1,330	Utility issue fee (or reissue)	[]
1502	480	Design issue fee	[]
1503	640	Plant issue fee	[]
1460	130	Petitions to the Commissioner	[]
1807	50	Processing fee under 37 CFR 1.17(q)	[]
1806	180	Submission of Information Disclosure Statement	[]
8021	40	Recording each patent assignment per property (times number of properties)	[]
1809	770	Filing a submission after final rejection (37 CFR 1.129(a))	[]
1810	770	For each additional invention to be examined (37 CFR 1.129(b))	[]
1801	770	Request for Continued Examination (RCE)	[]
1802	900	Request for expedited examination of a design application	[]
1504	300	Publication fee for early, voluntary, or normal publication	[]
1505	300	Publication fee for republication	[]
1455	200	Filing application for patent term adjustment	[]
1456	400	Request for reinstatement of term reduced	[]
		Other fee (specify) Terminal Disclaimer	[110]

* Reduced by Basic Filing Fee Paid

SUBTOTAL

\$110

SUBMITTED BY		Complete (if applicable)	
NAME AND REG. NUMBER	Jeffrey L. Ihnen, Reg. No. 28,957		
SIGNATURE	<i>Dorinda G. Ernst #30377 for Jeffrey L. Ihnen</i>	DATE	May 19, 2004
		DEPOSIT ACCOUNT USER ID	